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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,089	01/17/2002	Toshio Inase	218233US2	5580
22850	7590	05/06/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.			ANGEBRANDT, MARTIN J	
1940 DUKE STREET			ART UNIT	
ALEXANDRIA, VA 22314			PAPER NUMBER	

1756

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary	Application No. 10/047,089	Applicant(s) INASE ET AL.	
	Examiner Martin J Angebranndt	Art Unit 1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 and 9-12 is/are allowed.
- 6) ☒ Claim(s) 5,6,8,13,14 and 16 is/are rejected.
- 7) ☒ Claim(s) 7 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/06/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. The response provided by the applicant has been read and given careful consideration. Responses to the arguments of the applicant are presented after the first rejection to which they are directed. The IDS of 12/2002 has been made of record and a signed copy accompanies this mailing. The rejection based upon JP 07-161072 is withdrawn based upon the lack of a teachings of a more limited range within the reference. The references only teaches 1:9 to 9:1 [0018] and the data provided by the applicant in the comparative examples does demonstrate a criticality in the amounts. The examiner did not find the arguments evoking In re Kotzab prusasive as it does not address the issue of disclosed equivalence of the materials as high thermally conductive dielectrics. The rejection based upon Nonaka et al. '753, in view of Ohbayashi et al. '039 with withdrawn for the same reasons.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 5-6,8,13-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakanishi et al. '232

Nakanishi et al. '232 exemplifies in example 14, a phase change optical recording medium which uses a mixture of TiC:SiO₂ (4:6) for one of the protective layers. Example 12 uses a mixture of ZrC:SiO₂ (3:7) for one of the protective layers. The use of oxides of Al and the use of silicon carbides is disclosed. (7/29-55)

It would have been obvious to one skilled in the art to modify the invention of the examples by choosing other combinations, such as aluminum based upon the disclosure of

equivalence in column 7 of the reference. Further, it would have been obvious to one skilled in the art to use SiC in place of the carbides in the resulting combination based upon the language of equivalence with a reasonable expectation of achieving comparable results.

The applicant's analysis misses the language "..... and their compounds are preferred because of their excellent heat resistance, etc. In the case of the compound film, a compound film comprising ZnS and SiO₂ ..." (col 7/lines 33-55), which clearly indicates that mixtures of the recited members are contemplated by the reference and in reciting oxides as a group asserts an equivalence of the oxides of the recited elements. This disclosure of equivalence and the relative amounts of the oxide and carbides in the cited examples combine to meet the standard of obviousness. The applicant may have a experimental results, showing that the use of silica, produces a different result than when alumina is used as the oxide, but this is not on the record. Again the In re Kotzab decision seems misapplied in this case as a clear disclosure of equivalence for the oxides as a class, as well as for carbides as a class, is present in the references.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

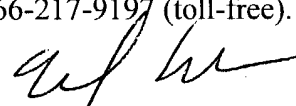
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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J Angebrannndt whose telephone number is 571-272-1378. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Martin J Angebrannndt
Primary Examiner
Art Unit 1756

05/05/2004